

REMARKS

Reconsideration and withdrawal of the outstanding grounds of rejection are respectfully requested in light of the above amendments and the remarks that follow.

The Examiner has rejected claims 1-9 under 35 U.S.C. 112, second paragraph as indefinite, alleging that the term "substantially" as used in claim 9, line 2 renders the claim indefinite. Applicant respectfully traverses this ground of rejection. In support of the rejection, the Examiner contends that the specification does not provide a standard for ascertaining the requisite definition for the term "substantially" so that one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Note that on page 1 of the specification, it is explained that the coating is applied to the field coils but that the ends of the copper bars may be masked to prevent powder coverage where not desired, for example, at the site of the electrical connections. Thus, when claims 1 and 9 refer to a winding that is substantially entirely coated with a powder resin, one of ordinary skill in the art would well understand that the coil is coated everywhere but at small areas where coatings are not desired, for example, where the electrical connections are made.

Moreover, the term "substantially" has long been accepted in the USPTO without further definition in order to provide appropriate protection for inventions where, otherwise, minor immaterial changes could arguably avoid infringement. Accordingly, reconsideration and withdrawal of this ground of rejection is requested.

The Examiner has also objected to the term "in the range of at least 155-220° C. as utilized in claim 2.

Applicant has amended the phrase at issue to require a thermal stability above 155° C., overcoming this ground of rejection.

With respect to the informality identified by the Examiner in claim 3, applicant has deleted the word "an" preceding "electrical connector," thereby overcoming this ground of rejection.

The Examiner has rejected claims 1-9 under 35 U.S.C. 103(a) as unpatentable over Prostor in view of Japan '606. According to the Examiner, Prostor discloses the claimed invention except for the utilization of a powder resin having a dielectric strength as required by claim 1.

The Examiner relies upon Japan '606 for disclosure of a coating formed of a silicon powder resin having a high dielectric strength, and contends that it would have been obvious to employ the coating composition of the '606 reference for the coating composition in Prostor.

Applicant has amended independent claims 1 and 9 so that each of the independent claims require the powder resin to have a dielectric strength of at least 1000 v/mil and a thermal stability of above 155° C.

The Japan '606 reference does not appear to disclose a coating composition for a coil. In both the "Abstract" and "Constitution" sections of the English language abstract, reference is made to a composition diluted with an organic solid and impregnated and hardened on a coil whereon an insulated wire is wound. It is not at all apparent that the composition disclosed in the '606 reference is a coating as utilized in the claims of this application. Moreover, applicant is unable to find any disclosure or teaching that the

composition in the Japan '606 reference has the required dielectric strength and thermal stability required by claims 1 and 9. The mere disclosure of a resin having a "high dielectric strength" is insufficient to create *prima facie* obviousness with respect to claims at issue here. Moreover, with regard to thermal stability, the Examiner points out to Prostor's coating at column 2, lines 20-30 as operable in a high temperature environment. This rationale is clearly improper since the Examiner has already taken the position that it would have been obvious to utilize the resin composition of the Japan '606 patent for the coating composition in Prostor. The Examiner cannot utilize the properties of two different coating compositions to justify the Section 103 ground of rejection.

It is respectfully submitted that the combination of references applied by the Examiner is insufficient to create *prima facie* obviousness with respect to any of remaining claims 1 and 3-9.

The application is now in condition for immediate allowance, and early passage to issue is requested. In the event, however, any small matters remain outstanding, the Examiner is encouraged to telephone the undersigned so that the prosecution of this application can be expeditiously concluded.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page(s) is captioned "Version With Markings To Show Changes Made."

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADEIN THE CLAIMS

Amend claims 1, 3 and 9 as follows:

1. (Amended) A field coil for an electromagnetic rotor comprising multiple windings, [each] said windings substantially entirely coated with a powder resin having a dielectric strength of at least [in the range of] 1000[-1500] v/mil, and a thermal stability above 155° C.

3. (Amended) The field coil of claim 1 wherein [an] electrical connector portions of the field coil are not coated.

9. (Amended) A field coil for an electromagnetic rotor comprising a field coil substantially entirely coated with a powder resin selected from a group consisting essentially of epoxy powder resins and silicone powder resins, wherein said powder resin has a dielectric strength of at least 1000 v/mil and thermal stability above 155° C.